UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This final action is in response to the amendment filed on: 04/18/08.

2.   Claims 1, 9, and 18 are amended. Claims 1, 9, and 18 are independent claims.

Claims 1-26 are pending.

3.   The following claims are withdrawn, in view of new grounds of rejection

necessitated by the applicant's amendment:

- Claims 1, 2, 4-7, 9-11, 13-16, 18-20, 22-25 rejected under 35 U.S.C. 102(b) as being

  anticipated by Lopresti et al.

- Claims 3, 12, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable

  over Lopresti et al, in view of Zlotnick.

- Claims 8, 17, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable

  over Lopresti et al, in view of Wanderski et al

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

4.   Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

With regards to claim 1, the claimed "system" appears to be a "computer

program per se", without hardware. Since the computer program is not embodied in a

computer readable medium, the claim is not statutory. See MPEP 2106 below:

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held non statutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and thus statutory.

With regards to claims 2-8, for depending upon a rejected independent claim 1, as explained above, are rejected under similar rationale.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5.   Claims 1, 2, 4-7, 9-11, 13-16, 18-20, and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakatani (US Patent: 5,438,657, issued: Aug. 1, 1995, filed: Mar. 11, 1993).

With regards to claim 1, Nakatani teaches: *A comparison system adapted to compare one or more elements of at least a portion of an original document against the same types of elements in at least a portion each of a plurality of stored documents, wherein the portion of the original document is the portion that requires adjustment or re-layout* (Abstract, column 1, lines 52-67, and column 2, lines 1-37: whereas, a

comparison system is adapted to compare one or more data elements of a portion of

one of document against the same types of a plurality of given/stored documents , such

that the portion of the original document is properly adjusted to reflect the layout of the

stored/given document).

A determination system adapted to identify the stored document with the portion which

is closest to the portion of the original document based on the comparing (column 2,

lines 19-37: whereas the portions that are identified using the stored/given document

are matched to the portion in the original document).

A mutation system adapted to apply one or more mutators to the portion of the original

document which were applied to mutate the portion of the identified stored document,

wherein mutators include at least one of a font type adjustor, a line spacing adjustor, at

least one color adjustor and at least one section location adjustor in the portion of the

original document (whereas, as taught in column 18, lines 4-55: section location/layout

adjustment is implemented in the portion of the original document).

With regards to claim 2, which depends on claim 1, Nakatani teaches *the system*

further comprising a selection system that selects the portion of the original document

for comparing (column 18, lines 4-55: whereas, sections are selected based upon

different granularity i.e. blocks)

With regards to claim 4, which depends on claim 1, Nakatani teaches *further*

comprising an ordering system that determines an order for the mutation system to

apply the mutators to the original document (column 18, lines 4-55: whereas a mutation

system/layout-conversion is implemented to apply mutators for ordering an original

document)

With regards to claim 5, which depends on claim 1, Nakatani teaches *further*

comprising an application system that determines which one of the one or more

mutators which were used in the portion of the identified stored document are to be

used by the mutation system on the original document (Abstract: whereas, the

mutators/changes- necessary to create a stored document, are captured such that

mutators are used on the original document to sustain a consistent layout)

With regards to claim 6, which depends on claim 1, Nakatani teaches *further*

comprising an output system which outputs the original document after application of

the mutators (Abstract: whereas, the original document is converted after application of

mutators indicated from learning data)

With regards to claim 7, which depends on claim 6, Nakatani teaches an

identification system that identifies the output system wherein one of the elements used

in the comparison system is the identified output system against an output system used

for each of the stored documents and wherein the determination system uses the

comparison of the identified output system against an output system used for each of

the stored documents in identifying the stored document with the portion which is

closest to the portion of the original document (column 18, lines 29-35: whereas, the

output system identified is based upon the output system of one or more stored

documents given for learning/layout-processing)

With regards to claim 9, for performing a method similar to the method performed

by the system of claim 1, is rejected under similar rationale.

With regards to claim 10, for performing a method similar to the method

performed by the system of claim 1, is rejected under similar rationale.

With regards to claim 11, which depends on claim 9, for performing a method

similar to the method performed by the system of claim 2, is rejected under similar

rationale.

With regards to claim 13, which depends on claim 9, for performing a method

similar to the method performed by the system of claim 4, is rejected under similar

rationale.

With regards to claim 14, which depends on claim 9, for performing a method similar to the method performed by the system of claim 5 is rejected under similar rationale.

With regards to claim 15, which depends on claim 9, for performing a method similar to the method performed by the system of claim 6, is rejected under similar rationale.

With regards to claim 16, which depends on claim 9, for performing a method similar to the method performed by the system of claim 7, is rejected under similar rationale.

With regards to claim 18, for a computer readable medium, performing a method similar to the method performed by the system of claim 1, is rejected under similar rationale.

With regards to claim 19, which depends on claim 18, for a computer readable medium, performing a method similar to the method performed by the system of claim 1, is rejected under similar rationale.

With regards to claim 20, which depends on claim 18, for a computer readable medium, performing a method similar to the method performed by the system of claim 2, is rejected under similar rationale.

With regards to claim 22, which depends on claim 18, for a computer readable medium, performing a method similar to the method performed by the system of claim 4, is rejected under similar rationale.

With regards to claim 23, which depends on claim 18, for a computer readable medium, performing a method similar to the method performed by the system of claim 5, is rejected under similar rationale.

With regards to claim 24, which depends on claim 18, for a computer readable medium, performing a method similar to the method performed by the system of claim 6, is rejected under similar rationale.

With regards to claim 25, which depends on claim 18, for a computer readable medium, performing a method similar to the method performed by the system of claim 7, is rejected under similar rationale.

6.   Claims 3, 12, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Nakatani (US Patent: 5,438,657, issued: Aug. 1, 1995, filed: Mar. 11, 1993), in

view of Zlotnick (US Patent: 6,778,703 B1, issued: Aug. 17, 2004, filed: Apr. 19, 2000).

        With regards to claim 3, which depends on claim 1, Nakatani teaches wherein

the determination system further comprises a comparison system adapted to compare

one or more elements of at least a portion of the original document against each of the

portions of the plurality of stored documents, as similarly explained in the rejection for

claim 1.

        However, Nakatani does not expressly teach *a scoring system that generates a*

score for each of the comparisons of the portion of the original document against each

of the portions of each of the plurality of stored documents, wherein the determination

system identifies the stored document with the portion with the score which is closest to

the portion of the original based on the generated scores.

Zlotnick teaches a determination system further comprises a scoring system that

generates a score for *each of the comparisons of the portion of the original document*

against each of the portions of each of the plurality of stored documents, wherein the

determination system identifies the stored document with the portion with the score

which is closest to the portion of the original based on the generated scores (column 2,

lines 38-45: whereas, the 'current'/original document/template is, being compared to

other document/templates, and a stored document/template is selected based on the

closes matching score).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Nakatani's determination system such that it would have

included a comparison ranking system for selection of the closest matched stored

document as taught by Zlotnick. The combination of Nakatani and Zlotnick would have

allowed Nakatani's system to have "provided improved methods for automatically

identifying which of a plurality of templates (documents) corresponds to a given form

document" (Zlotnick, column 2, lines 10-14).

With regards to claim 12, which depends on claim 9, for performing a method

similar to the method performed by the system of claim 3, is rejected under similar

rationale.

With regards to claim 21, which depends on claim 18, for a computer readable

medium, performing a method similar to the method performed by the system of claim

3, is rejected under similar rationale.

7.   Claims 8, 17, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Nakatani (US Patent: 5,438,657, issued: Aug. 1, 1995, filed: Mar. 11, 1993), in

view of Wanderski et al (US Patent: 6519617 B1, issued: Feb. 11, 2003, filed: Apr. 8,

1999)

With regards to claim 8, which depends on claim 1, Nakatani et al does not

expressly teach *further comprising storing the output, original document with the applied*

mutators as one of the stored documents.

However, Wanderski et al teaches a system comprising storing the output, original

document with the applied mutators as one of the stored documents (column 14, lines

48-52: whereas, the DTD contains one or more mutators for the document, and the

generated output can be stored for later processing).

It would have been obvious to one of the ordinary skill in the art at the time of the

invention to have modified Nakatani system to have further included the ability to store

the output as one of the stored documents as taught by Wanderski et al. The

combination of Nakatani and Wanderski et al would have allowed Lopresti et al's

system to have "automatically transformed documents using dynamically –selected

transformations" (Wanderski et al, column 4, lines 13-14).

With regards to claim 17, which depends on claim 9, for performing a method

similar to the method performed by the system of claim 8, is rejected under similar

rationale.

With regards to claim 26, which depends on claim 18, for a computer readable

medium, performing a method similar to the method performed by the system of claim

8, is rejected under similar rationale.

Response to Arguments

8.   Applicant's arguments with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILSON TSUI whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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